



**MAILED**

**OCT 04 2012**

**OFFICE OF PETITIONS**

LAW FIRM OF ANDREA HENCE EVANS  
14625 BALTIMORE AVENUE, #853  
LAUREL, MD 20707

In re Patent of Mia Minnelli	:	
Patent No. 6,263,884	:	
Issue Date: July 24, 2001	:	Letter
Application No. 09/525,601	:	
Filing Date: March 14, 2000	:	
Attorney Docket No. Mia Minnelli	:	

**REQUEST FOR INFORMATION**

This letter addressed the renewed petition under 37 C.F.R. § 1.378(b) filed May 22, 2012.

Petitioner should submit the requested information within **TWO MONTHS** of the mailing date of this letter.<sup>1</sup> Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter titled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

The instant letter is being issued in order to provide Petitioner with an opportunity to supplement the record.

**The Burden of Proof**

35 U.S.C. § 41(c)(1) states, with emphasis added, "The Director may accept the payment of any maintenance fee . . . after the six month grace period **if the delay is shown** to the satisfaction of the Director to have been unavoidable." 37 C.F.R. § 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include, with emphasis added,

**A showing** that . . . reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee . . . became aware of . . . the expiration of the patent. The showing must enumerate the steps taken to

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<sup>1</sup> If Petitioner cannot satisfy the time limit, Petitioner (directly or via a registered practitioner) should contact the undersigned to discuss the matter.

ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent.

Since both 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b) require the submission of a “showing,” a party filing a petition under 37 C.F.R. § 1.378(b) has the burden of proof. In other words, a petition under 37 C.F.R. § 1.378(b) can only be granted if the record includes sufficient evidence to “show” the delay was unavoidable.

### **The Unavoidable Standard**

A grantable petition under 37 C.F.R. § 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to show the delay in the submission of a maintenance fee was unavoidable, the party must show “reasonable care was taken to ensure that the maintenance fee would be promptly paid.”<sup>2</sup> The level of “reasonable care” required to be shown is the same as the level of “care or diligence ... generally used and observed by prudent and careful men in relation to their most important business.”<sup>3</sup> When determining if a period of delay has been shown to have been unavoidable, the Office will take “all the facts and circumstances into account” and will decide each petition “on a case-by-case basis.”<sup>4</sup>

### **Background**

The owner of the patent is The Tonytail Company, Inc. (“Petitioner”).

Mia Minnelli is the sole inventor of the patent at issue and is the Chief Executive Officer of Tonytail.<sup>5</sup>

The patent issued on July 24, 2001.

Minnelli has stated she created a database for maintenance fee due dates and entered the due dates into a calendar.<sup>6</sup>

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<sup>2</sup> 37 CFR 1.378(b).

<sup>3</sup> *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). *See also Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) (“[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.”).

<sup>4</sup> *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

<sup>5</sup> Papers filed in this case refer to the inventor as both Mia Minnelli and Mia Minnelli Kaminski. The instant decision assumes the correct name for the inventor is Mia Minnelli.

<sup>6</sup> *See Showing of Unavoidable Delay to Pay Maintenance Fees* filed February 2, 2012.

The 3.5 year maintenance fee was timely paid on December 31, 2004, which was five months and seven days after the first date the fee could have been timely paid.

The 7.5 year maintenance fee could have been paid from July 24, 2008, to January 26, 2009, or with a surcharge from January 27, 2009, to July 24, 2009.

Minnelli began undergoing fertility treatments during March 2009.

The 7.5 year maintenance fee was not paid on or before July 24, 2009. As a result, the patent expired on July 25, 2009.

In late July or early August of 2009, Minnelli became pregnant.

During November 2009, approximately four months after the expiration of the patent, Minnelli suffered a miscarriage.

During early 2010, Minnelli began a new set of fertility treatments.

Minnelli was diagnosed with two brain tumors during April 2010. The first tumor was removed on June 11, 2010.

After the removal of the first tumor, doctors determined (1) Minnelli could resume receiving fertility treatments, (2) determined Minnelli should be on bed rest, and (3) determined Minnelli should limit her job duties. Petitioner has not identified the length of time Minnelli actually spent on bed rest or the exact extent to which Minnelli limited her job duties.

During September 2010, Minnelli became pregnant again as a result of fertility treatments.

The instant petition includes a letter signed by Doctor Mitchell Rosen on behalf of the UCSF Medical Center. The letter states, "[W]ith all the appointments and numerous diagnostic procedures, which included MRI's, biopsies and a constant barrage of blood tests, [Minnelli] found it extremely difficult to maintain any sort of work schedule."

Minnelli's gave birth to a baby girl during June 2011.

The previously cited letter from the UCSF Medical Center states, "Following the birth of her daughter, [Minnelli] was inundated with maternal responsibilities that continued to impact her work schedule."

The record does not contain any letter from any doctor addressing the extent to which Minnelli's health, rather than the fact she gave birth to a child, impacted Minnelli's ability to perform her job duties after June 2011.

On January 23, 2012, Minnelli engaged The Law Firm of Andrea Hence Evans, LLC ("Firm") to handle various patent prosecution matters. The Firm subsequently notified Minnelli the instant patent had expired.

The instant petition appears to indicate the second tumor previously discussed has never been removed. The petition states the second tumor makes it difficult for Minnelli to speak for more than ten minutes at a time, causes Minnelli pain, and causes Minnelli to be very irritable.

The 7.5 year maintenance fee could have been paid from July 24, 2008, to January 26, 2009, or with a surcharge from January 27, 2009, to July 24, 2009. The fee was not timely paid. As a result, the patent expired on July 25, 2009.

A petition under 37 CFR 1.378(b) was filed February 2, 2012, and was dismissed in a decision mailed March 22, 2012.

The instant request for reconsideration was filed May 22, 2012.

### **Discussion**

#### **I. Steps in Place to Ensure the Maintenance Fee Would be Timely Paid**

Unfortunately, the prior decision failed to explicitly request Petitioner supply a copy of the portions of the calendar and a "print out" of portions of the database that are relevant to the issues in this case. As a result, the Office is unable to take the following actions:

- (1) Verify entries were made into both the calendar and database,
- (2) Verify the entries did not include any incorrect information that may have contributed to Petitioner's failure to timely pay the fee, and
- (3) Determine the docket date for the 7.5 year maintenance fee in the calendar and the database.

Petitioner's response to the instant request should include a copy of all relevant portions of the calendar and database.

#### **II. The Failure to Timely Submit the 7.5 Year Maintenance Fee**

The request for reconsideration fails to identify the date ("D-Date") Petitioner is alleging the 7.5 year maintenance fee would have been timely paid but for Petitioner's health problems. Any response to the instant request should clearly identify the date on which Petitioner is alleging the 7.5 year maintenance fee would have been timely paid but for Petitioner's health problems.

The request for reconsideration only identifies *one* health problem relevant to the time period during which the 7.5 year maintenance fee could have been timely paid. Specifically, the request for reconsideration indicates Petitioner was having problems becoming pregnant.

The request for reconsideration fails to identify the exact impact, if any, that Petitioner's inability to become pregnant had on Petitioner's ability to consult her calendar and/or the database, recognize the 7.5 year maintenance fee was due for the patent, and pay the maintenance fee.

Any response to the instant request should *fully* identify and discuss the impact Petitioner's problems with becoming pregnant had on each of the following:

- (1) Petitioner's ability to consult her calendar and/or the database,
- (2) Petitioner's ability to recognize the 7.5 year maintenance fee was due, and
- (3) Petitioner's ability to timely pay the 7.5 year maintenance fee.

The request for reconsideration states Petitioner began receiving fertility treatments during March 2009. The Office notes, if for reconsideration fails to identify the exact impact, if any, that Petitioner's fertility treatments had on Petitioner's ability to consult her calendar and/or the database, recognize the 7.5 year maintenance fee was due for the patent, and pay the maintenance fee.

Any response to the instant request should *fully* identify and discuss the impact the fertility treatments had on each of the following:

- (1) Petitioner's ability to consult her calendar and/or the database,
- (2) Petitioner's ability to recognize the 7.5 year maintenance fee was due, and
- (3) Petitioner's ability to timely pay the 7.5 year maintenance fee.

The prior decision mailed by the Office on March 22, 2012, states, with emphasis added,

If a request for reconsideration is filed, the request should identify and fully discuss the *exact extent* to which Ms. Minnelli's health problems limited her ability to be employed, or to perform job duties, *during the entire relevant time period*.

The request for reconsideration fails to identify a single day that Petitioner missed work as a result of health problems during the time period beginning on the date two weeks prior to the D-Date date and ending on the last date the 7.5 year maintenance fee could have been timely paid. Any response to this request should identify all dates Petitioner missed work as a result of health problems during the time period beginning on the date two weeks prior to the D-Date date and ending on the last date the 7.5 year maintenance fee could have been timely paid.

The Office's March 22, 2012 decision states, with emphasis added,

The petition fails to discuss the number of individuals employed by Tonytail *during 2009*, or discuss the extent to which Ms. Minnelli could have shifted the burden of timely paying the maintenance fee to another employee once she became unable to handle such a burden due to her health.

The request for reconsideration states the other employees were not qualified to handle the company's finances or intellectual property. Specifically, the request for reconsideration states, with emphasis added,

[Ms. Minnelli was the sole employee responsible] for paying maintenance fees for the company's intellectual property.... This duty was not assigned to [any other] employee

during the time period in which the above patent application maintenance fee was due. The [other] employees are not qualified to support Tonytail's intellectual property as they are recent high school and college graduates who [were not] given the responsibility to *handle the company's finances* and intellectual property.

The prior language strongly implies Petitioner handled the company's finances during the time period the 7.5 year fee could have been timely paid. Any request for reconsideration should fully discuss the extent to which Petitioner handled Tonytail's finances during the time period beginning two weeks prior to the date Petitioner alleges the 7.5 year fee would have been timely paid but for health difficulties and ending on the last date the fee could have been timely paid.

The extent to which Petitioner was able to make timely payments of fees concerning other matters is *extremely* relevant to Petitioner's ability to pay the 7.5 year fee. Therefore, any response to the instant request should identify and discuss the following:

- (1) All monetary payments, such as bills and invoices, which were timely made by Petitioner during the period beginning on the date two weeks prior to the D-Date and ending on the last date the 7.5 year fee could have been timely paid, and
- (2) All monetary payments, such as bills and invoices, which were not timely made by Petitioner during the period beginning on the date two weeks prior to the D-Date and ending on the last date the 7.5 year fee could have been timely paid.

The discussion of health problems encountered by Petitioner after the last date the 7.5 year fee could have been timely paid implies Petitioner's ability to attend business meetings, give speeches, and travel *may* have been adversely impacted by health problems prior to the last date the 7.5 year fee could have been timely paid. Any response to the instant request for reconsideration should fully discuss the extent to which Petitioner's health problems impacted her ability to attend business meetings, give speeches, and travel.

The request for reconsideration asserts the other employees at Tonytail were not qualified to handle the company's finances or intellectual property. However, the request for reconsideration does not state all of the other employees were incapable of reviewing Minnelli's calendar and the database to determine if any maintenance fees were due for Petitioner's patents. Therefore, any response to this request should explain why Petitioner failed to have any other employee check her calendar (or the database) to see if any maintenance fees were due for any patents.

### **III. The Period of Delay from July 25, 2009, to October 31, 2009**

A reasonable and prudent person, who is responsible for ensuring extremely important deadlines are satisfied, would take steps to determine if any of the deadlines had been missed upon after missing one or more days of work due to health reasons. The record fails to identify any steps taken by Petitioner during the time period beginning July 25, 2009, and ending March 31, 2010, to determine if any prior deadlines had been missed. For example, the record fails to indicate Petitioner reviewed her calendar or the database to determine if any deadlines had been missed.

Any response to the instant request should fully identify and discuss the following:

- (1) The extent to which Petitioner took steps to determine if she had missed any past deadlines due to her health problems, and
- (2) The extent to which, if any, Petitioner's health prevented Petitioner from taking steps to determine if she had missed any past deadlines due to her health problems.

#### **IV. The Period of Delay from November 2009 to March 31, 2010**

Petitioner suffered a miscarriage during November 2009. The request for reconsideration fails to address the impact the miscarriage had on Petitioner's ability to take steps to determine if she had missed any past deadlines due to her health problems.

Any response to the instant request should fully identify and discuss the following for each month during the time period beginning November 2009, and ending March 2010:

- (1) The extent to which Petitioner took steps to determine if she had missed any past deadlines due to her health problems, and
- (2) The extent to which, if any, the miscarriage prevented Petitioner from taking steps during the month to determine if she had missed any past deadlines due to her health problems.

#### **V. The Period of Delay from April 1, 2010 to January 22, 2012**

The current record fails to establish Petitioner took any steps during the time period beginning April 1, 2010, and ending January 22, 2012, to determine if any prior maintenance fee due dates had been missed. For example, the record fails to establish Minnelli consulted her calendar or the database to determine if any maintenance fee due dates had been missed.

Any response to the instant request should fully identify and discuss the following for each month during the time period beginning April 2010 and ending January 2012:

- (1) The extent to which Petitioner took steps to determine if she had missed any past deadlines due to her health problems, and
- (2) The extent to which, if any, Petitioner's health problems prevented her from taking steps during the month to determine if she had missed any past deadlines due to her health problems.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.<sup>7</sup> Document Code "PET.OP" should be used if the request is filed electronically.

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<sup>7</sup> General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney  
Steven Brantley at (571) 272-3203.



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